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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,563	05/10/2001	Hirokazu Uchio	B422-150	6252

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EXAMINER

RONES, CHARLES

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,563

Applicant(s)

UCHIO ET AL.

Examiner

Charles L. Rones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

The amendment timely filed on September 24, 2003 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The statement in claims 27, 31, and 32 of "in case of displaying" is not clear wherein it is already stated that it is already that the list is being displayed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwai et al. U.S. Patent No. 5,175,681 ('Iwai').

Iwai discloses:

As to claim 27,

accumulation means for accumulating a related technical document for the patent application; See 9:25-67; 10:1-35; 17:1-25; 18:30-67; and

display control means for displaying a list of technical documents of said patent application and a corresponding foreign application of said patent application accumulated in said accumulation means, in case of displaying a list of technical documents of said patent application; See 9:25-67; 10:1-35; 17:1-25; 18:30-67.

As to claim 8,

wherein said display control means displays a flag indicating whether or not a prior art disclosure procedure has been performed on the technical document; See 9:25-67; 10:1-35; 17:1-25; 18:30-67.

As to claim 29,

wherein said display control means displays descriptions indicating correspondence between the technical document and a rejection reason; See 9:25-67; 10:1-35; 17:1-25; 18:30-67.

As to claim 30,

wherein said display control means displays a list of applications by which the technical document has been cited relating to the technical document; See 9:25-67; 10:1-35; 17:1-25; 18:30-67.

As to claim 31,

accumulating a related technical document including a corresponding foreign application for the patent application; See 9:25-67; 10:1-35; 17:1-25; 18:30-67; and

displaying and controlling a list of technical documents of a patent application and a corresponding foreign application of said patent application accumulated in said accumulation means, in case of displaying a list of technical documents of said patent application; See 9:25-67; 10:1-35; 17:1-25; 18:30-67.

As to claim 32,

a code for realizing an accumulation step of accumulating a related technical document including a corresponding foreign application for the patent application; See 9:25-67; 10:1-35; 17:1-25; 18:30-67; and

a code for realizing a displaying and controlling step of displaying a list of technical documents of a patent application and a corresponding foreign application of said patent application accumulated in said accumulation means, in case of displaying a

list of technical documents of said patent application; See 9:25-67; 10:1-35; 17:1-25; 18:30-67.

Response to Arguments

Applicant's arguments filed September 24, 2003 have been fully considered but they are not persuasive.

Applicant primarily argues that Iwai does not disclose displaying a list of technical documents and corresponding foreign application of the patent application.

In response, Examiner maintains that Iwai discloses displaying a list of technical documents and corresponding foreign application of the patent application wherein various foreign application information can be displayed and listed and including technical documents; See Fig. 24; 6:1-67; 24:44-53.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Rones whose telephone number is 703-306-3030. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.



Charles L. Rones
Primary Examiner
Art Unit 2175

December 2, 2003